

PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/807,018

Filed: March 23, 2004

For: Shingle With Sharply Defined Tabs Separated by Slots and Method of Making

Inventors: Husnu M. Kalkanoglu and Robert L. Jenkins

Examiner: Parker, Frederick John

Art Unit: 1792

Atty. Doc. No.: 116-03

REPLY BRIEF

This is in response to the Examiner's Answer of August 5, 2008.

I. The Goal Of An Invention Is Not The Legal Test For Patentability

The Examiner, not once, but 8 times in the Examiner's Answer confuses the **goals** of inventions with the different ways those goals are attained. Many shingle patents address the same goals, whether they are

- to appear thicker than they are;
- to give appearances of depth;
- to highlight certain characteristics;
- to reflect back heat from sunlight; or
- to inhibit bacterial growth.

But the method step features of the claims relative to what is or is not disclosed in the reference is what determines patentability; not the goal of the reference relative to the goal of the invention.

Many inventors may have the same very general goal and, where aesthetics are highly involved, as in the shingle art, there can be very many different avenues for reaching what any given inventor regards as his/her goal.

35 U.S.C. §101 states that one may obtain a patent for “any new and useful process ...”. **Goal** is not an issue.

35 U.S.C. § 103 allows patentability for the “...subject matter sought to be patented” [the claims] based upon the unobviousness of the differences from the prior art. The statute does not address “goals”.

Every entrepreneur/inventor and their competitors have some goals; they may be to build an engine to go faster; to fly higher; to process the ingredients to greater purity, etc.

It is how they approach their goals that may be the key to success.

It is the structure or function that counts; not the goal.

To say, over and over again (8 times) that both Koschitzky and Applicants have the same “goal” is no substitute for the inability to point to any place in the Koschitzky reference where the **complete removal** of the transition areas is disclosed.

Moreover, Koschitzky’s “goal” is different than the goal of Applicants here.

Koschitzky has his own idea of what he regards as a goal. And that is to remove an intermediate portion of a transition area, leaving “a portion of a transition area on each side of each slot” to provide his idea of what would be to him a desirable “accentuated visual demarcation between adjacent patches of granules”, as is spelled out in Koschitzky claim 1.

Applicants, here, have a different goal; namely the complete removal of the transition areas, so that what remains is two adjacent, distinct tabs, with different contrast or color from tab to tab, to give the appearance of individual tiles or slates when the shingles are laid up on a roof. (see specification page 1 line 20 through page 2 line 17, including the Summary of Invention; see also paragraphs 18 and 19 of the Snyder Declaration)

II. The Examiner’s Attempt To Torture The Crux Of This Invention Out Of Koschitzky Misfires

The crux of the invention here is the cutting of slots so that they completely remove the intermediate areas between different adjacent tabs, to achieve the inventors’ desired aesthetic.

Koschitzky cuts slots and removes always a **portion only**, and always leaves a major portion of the transition [intermediate] areas present, some on each side of the slot, in order to achieve Koschitzky's different desired aesthetic.

Throughout the Examiner's Answer, it is five times flatly stated or suggested that the partial removal of the transitional areas of Koschitzky is only a preference.

But the "preference" Koschitzky discloses is **always** within the framework of a **partial removal**. And that preference **within the framework of partial removal** is of that "...part of the transitional area where the two blends are approximately equal".
(Column 5 lines 17-19).

Every example given in the text of Koschitzky leaves a major portion of the transitional area intact.

Every drawing of Koschitzky shows major portions of the transitional area on each side of the removed slot intact.¹

And the claims- - where the invention of Koschitzky is focused- - all absolutely require that the "...transitional areas being of greater width than the slots so that there is a portion of a transitional area on each side of each slot...". This is a positive recitation, a **requirement** in the claims - - the very place where Koschitzky is seeking to protect what is important to him in his invention- - that there must be part of the transition area on each side of each slot. If this is not the clearest "teaching away" from Applicants' invention that there could ever be then no amount of "teaching away" could ever satisfy the Examiner in favor of patentability.

Any fair reading of Koschitzky precludes complete removal of the transitional areas.

Against all of this, the Examiner adamantly states:

"It remains the Examiner's position that Koschitzky includes the removal of all of the transitional zone..."

To say that a reading of Koschitzky fairly allows that partial removal is only a "preferred embodiment" as does the Examiner, has utterly no support in Koschitzky and is merely argument without any evidentiary support whatever.

1. As to Fig. 11, the brief description of Fig. 11 incorporates by reference the disclosure of Fig. 6.

The Examiner is unfairly stretching the **preference** of Koschitzky for removal of **only that portion** of the transitional area **where the blends are equal**, beyond anything disclosed, suggested or contemplated by Koschitzky and which the totality of Koschitzky teaches away from.

The only place in this entire record where the complete removal of the transition area exists is in Applicants' own disclosure, which, as a matter of law may not be used as "hindsight" to modify Koschitzky, as the Supreme Court in *KSR International Co. v. Teleflex Inc. et al* 127 S. Ct. 1727; 167 L. Ed. 2d 705; 82 U.S.P.Q. 2D (BNA) 1385 reminded us in its specific citation of *Graham v. John Deere Co.* 383 U.S. 1, 17-18, 86 S. Ct. 684, 15 L. Ed. 2d 545.

The Examiner did not deny some level of hindsight gleaned from the inventors here, but after-the-fact sought to minimize the temptation of "slipping into use of hindsight" in stating:

The Examiner experienced *little* temptation or "slippage into use of hindsight" in concluding the instant claims are obvious over the prior art (emphasis added).

Koschitzky is no basis for the rejection of Applicants' claims, and to torture a reference like Koschitzky based even upon a "little" temptation to do so, gleaned from Applicants' disclosure is exactly what the Supreme Court cautioned against in citing *Graham v. John Deere Co.* in their KSR decision.

In paragraph 6 of the Examiner's Answer the Examiner once again misrepresents Mr. Snyder's opinion as though Mr. Snyder opined that the claims are not obvious merely because they are not "expressly" taught in the art. That is not Mr. Snyder's testimony. See section 6 of the argument section of Applicants' main Brief starting on page 14. Mr. Snyder bases his opinion on 34 years of experience and knowledge of the shingle art. He never used the word "expressly". That word comes solely from the Examiner.

III. Over Fifty Years Of The Reality Of Patent Office Practice Versus the Examiner's Interpretation of Pre-1952 Act *In re Seid* Mandates Patentability of the Claims

In the roofing shingle art, the significant developments that have taken place, and which are the subjects of utility patents over the last 30 + years have in a great many cases been developments that are arguably manifested in ornamental or aesthetic features.

See for example the explanation of this development that runs through paragraphs 6-10 of the Snyder Declaration of record.

Also, as is addressed in paragraph 12 of the Snyder Declaration, of record, a great many of these developments are aimed at making manufactured asphalt shingles **look like** natural materials.

The expert, Mr. Snyder, points to 51 representative examples of method and/or product patents.

- they include surface irregularities on the shingles to appear like surfaces of slates or cedar shakes;
- they include the use of dark stripes to give the appearance of greater thickness, like natural materials have; and
- they include simulating a thatched roof.

The rest of the 51 such examples simulate other ornamental features of either natural shingles, or otherwise provide various other ornamentations.

Mr. Snyder provides these specific examples over 9 full pages of his Declaration. He points out that this has been the practice in the industry and of the Patent Office for many, many years.

While the Examiner states that he “...has no problem in these [ornamental features] being inventive appearances for roofing...” (page 9 of Examiner’s Answer) even though they are developments producing ornamental features, the Examiner nevertheless would bar Applicants’ development here, because under the Examiner’s interpretation of *In re Seid*, Applicants’ development here produces an ornamental feature.

In re Seid, as applied by the Examiner here, is not the law. *In re Seid*, decided in 1947, prior to the 1952 Patent Act, has never been cited for that proposition that the Examiner uses, in any other case.² The shingle industry and the Patent Office have a long history of recognizing the patentability of method and product claims in utility patents where the method steps or structural aspects produce ornamental features, and, to the extent that *In re Seid* would require that the features of the claims produce a

2. *In re Seid* has, however, been cited for completely different propositions; namely that a patent can be a reference as of its filing date or for accidental disclosure in the drawings.

“mechanical effect or advantage”, paragraphs 4 and 5 of the Snyder Declaration of record and page 12 of Applicants’ main Brief on Appeal address at least 9 such mechanical effects or advantages.

Moreover, the complete removal by itself of the intermediate areas where there are blends of granules from the tabs on each side of each slot produces a tenth advantage; namely that there is no dilution of the color or shading scheme of one tab by the color or shading scheme of an adjacent tab. See Exhibits B and C to the Snyder Declaration, and paragraphs 13-14 of the Snyder Declaration.

An eleventh advantage is produced in that the goal of the Applicants of causing the sharp delineation from tab to tab separated by slots, causes the individual tabs to give the appearance of individual tile or slates.

A twelfth advantage, of physical effect, is present in that, because the intermediate blend in each case is completely removed, these individual tabs necessarily become capable of reflecting distinct wave length distributions of mixed wave length photons impinging thereon from applied light, again to give the appearance of individual tiles or slates.

Thus, even if *In re Seid* were the current law, and some mechanical effect or advantage were required for article claims based on ornamentation, this invention produces at least twelve mechanical effects or advantages.

Furthermore, *In re Seid* applied only to article claims; not method claims, as the Examiner must well know. The very M.P.E.P. section that the Examiner cites three times on pages 7 and 8 of the Examiner’s Answer (2144.04 I) continues, in the same short paragraph, to cite Ex parte Hilton 148 U.S.P.Q. 356 for the proposition that shape that is distinct for a claimed article, from a referenced article, is patentable. Here the shape produced by complete removal of the intermediate areas causes the individual tabs to look like separate tiles or slates, which is different from the tabs of Koschitzky, just as the appearance of the french fries in Ex parte Hilton differed from the appearance of potatoes chips.

Moreover, in Ex parte Hilton it was a **given** that the process was patentable; the only issue there was whether or not the product was patentable. The claims of the instant application are **all process claims**.

There is no question but that neither *In re Seid* nor M.P.E.P. 2144.04 I has never had any applicability to process claims.

Accordingly, to the extent that the Examiner would find a requirement for any special mechanical effect for **article** claims from the language of *In re Seid*, (which is not cited for that proposition by any other case, in the last 61 years since that case was decided) in no respect does *In re Seid* address **method** claims in any way whatsoever.

What is significant in the consideration of method claims is the method steps involved, and there are no method steps involved in *In re Seid*. Accordingly, for this additional reason, the Examiner's reliance upon *In re Seid* in this instance, is submitted, to be misplaced.

Nothing in *In re Seid* should preclude patentability of Applicants' claims.

IV. Commercial Success is Established; the Examiner's Earlier Concerns Were Answered, but the Answer was Ignored

In numbered paragraph 7 of the Examiner's Answer the Examiner repeats the position set forth in the Final Rejection. That position is that the evidence of commercial success that was submitted as part of the Declaration of Mr. Snyder might have been, in the Examiner's opinion, the result of promotion, advertising, marketing, etc.

While the Examiner acknowledges that subsequent Declaration of Mr. Jenkins was submitted, the Examiner in no way deals with the substance of the Jenkins Declaration.

The Jenkins Declaration established, as is set forth in greater detail in numbered paragraph 7 of the argument section of Appellant's main Brief, that those other factors were "essentially the same" for the comparison commercially successful shingle to which the shingle of this invention was compared.

Thus, the Jenkins Declaration took **out of play** the only concerns of the Examiner about whether or not the Snyder Declaration established commercial success.

The record of this case establishes that the invention that is the subject of the claims in this application **was and is** a commercial success, in accordance with *Graham v. John Deere Co.*.

The commercial success of this invention supports the patentability of the claims being sought.

V. Conclusion

For all of the reasons set forth in Appellants' main Brief and this Reply Brief, the claims of this application should be allowed over the applied art.

The Examiner's rejection should be reversed.

Respectfully submitted,

/JFM/

John F. McNulty
Reg. No. 23,028
Paul & Paul
2900 Two Thousand Market Street
Philadelphia, PA 19103 (215) 568-4900